

*Serial Number: 10/046,573
Docket No.: 1243.002.4*

REMARKS

Reconsideration of the application and allowance of all claims pending herein is respectfully requested in view of the remarks below. Claims 1-11 are pending.

Initially, applicant gratefully acknowledges the allowance of claims 1-5 and 8-11.

Rejections Under § 102:

Claims 6 stands rejected under 35 U.S.C. § 102(e) as being anticipated Tal et al. (U.S. Patent No. 5,868,785). In particular, Tal et al. is alleged to disclose the method of claim 6 including a handle (443) having a drive head (FIG. 32) which moves distally to effect jaw closure, and having teeth (464) formed thereon. A pawl (462) is alleged to be positioned for engagement with the teeth so as to prevent proximal movement of the drive head after it has moved distally.

Claim 6 of the present application recites inter alia, a method for ratcheting the closure with a pair of jaws of an endoscopic grasping tool surgical instrument. The method includes the steps of providing a pivotally mounted actuator handle operatively coupled to the jaws and providing a pawl positioned for engagement with the teeth so as to prevent proximal movement of the drive head after it has moved distally. The handle has a drive head which moves distally to effect jaw closure and the drive head has teeth formed thereon.

As depicted in FIG. 32 of Tal et al., the handle 443 is connected to a yoke-like member 436. The yoke-like member is pivotally mounted on a pin 434 to allow movement of the yoke-like member. The pawl 462 engages teeth on a bottom side of handle 443. However, the teeth are not located on a drive head as recited in claim 6 of the present application. As described on page 10 of the present application, a drive head is positioned adjacent a chassis drive collar 98 which is moved by drive head 92 as it moves distally. Although claims should be given their broadest reasonable interpretation, a claim should be understood by "taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification" (MPEP § 2111). As noted above, claim 6 recites a handle having a drive head and the drive head having teeth formed thereon. It would not be reasonable for the entire handle to be considered the drive head considering page 10 described above and the recitation in claim 6 of a handle having a drive head. Accordingly, the entire yoke-like member of FIG. 32 of Tal et al. cannot be considered to be a drive head. Because any driving of actuator tube assembly 411 would be performed by the portion of the yoke-like member adjacent actuator tube assembly 411, this portion could be considered to be a drive head. However, the teeth depicted in this

*Serial Number: 10/046,573
Docket No.: 1242.002.1*

figure are not located on a portion of the yoke-like member which is adjacent the portion to be driven (i.e., actuator tube assembly 411). Instead, the teeth in FIG. 32 of Tal et al. are located below the portion of yoke-like member which would drive actuator tube assembly 411. Accordingly, Tal et al. cannot be considered to include a drive head having teeth formed thereon. Thus, because all the features (e.g., a drive head having teeth formed thereon) of claim 6 of the present application are not identically disclosed by Tal et al., this claim cannot be anticipated thereby. Thus, this claim is believed to be allowable.

Rejections Under § 103:

Claims 7 and 12 stand rejected under 35 U.S.C. § 103(a) as being obvious over Tal et al. In particular, Tal et al. is alleged to teach all of the limitations of these claims except a pawl comprising two tines of unequal length. It is alleged that it would have been obvious to one of ordinary skill in the art to provide a second tine since it has been held that mere duplication of essential working parts of the device involves only routine skill in the art.

Claim 12 of the present application recites, *inter alia*, a pawl comprised of two tines of unequal length so that each tine engages the teeth alternatively with the other, as the head moves distally.

As noted above, Tal et al. discloses a pawl engageable with teeth of a handle. However, there is no disclosure in this reference of the desirability of having unequal length tines which alternately engage a drive head as the head moves distally. Further, the use of unequal tines is not "mere duplication of essential working parts" as alleged in the Office Action. Instead, as described on the bottom of page 12, the utilization of unequal length tines allows finer increments in the ratcheting operation than if two tines were provided of equal length resulting from such a "mere duplication". In particular, the use of such unequal length tines would not be a mere duplication particularly because the tines themselves are not even duplicates of each other due to their unequal length. Further, there is no teaching, suggestion, or motivation disclosed in Tal et al. to provide two tines of unequal length. Thus, claim 12 cannot be obvious over this reference. Claim 7 is claimed to be allowable for the same reasons as those described relative to claims 1 and 12.

*Serial Number: 10/046,573
Docket No.: 1242.002.4*

CONCLUSION

It is believed that the application is in condition for allowance, and such action is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,

Victor A. Cardona

Victor A. Cardona, Esq.
Attorney for Applicant(s)
Registration No. 44,589

Dated: April 8, 2005

HESLIN ROTHENBERG FARLEY & MESITI, P.C.

5 Columbia Circle
Albany, New York 12203
Telephone: (518) 452-5600
Facsimile: (518) 452-5579